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First Named Inventor	Felix W. FENTER
Art Unit	3734
Examiner Name	L. Bachman
Attorney Docket Number	ANDEV-100

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Remarks

Response to Restriction Requirement with election and traverse

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENTFirm Name
Sherman & Associates

Signature

Printed name

Robert L. Haines

Date

November 20, 2006

Reg. No.

35,533

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ANDEV-100

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Felix W. FENTER, et al.

Serial No.: 10/791,733

Group: 3734

Filed: March 4, 2004

Examiner: L. Bachman

For: ANASTOMOSIS APPARATUS AND METHODS WITH COMPUTER-AIDED,
AUTOMATED FEATURES

Date: November 20, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the official action mailed October 19, 2006, to which a reply is due by November 19, 2006. November 19, 2006, being a Sunday, this response is timely filed Monday, November 20, 2006.

Restriction to one of the following inventions has been required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a cart for a surgical anastomosis apparatus, classified in class 606, subclass 153.
- II. Claims 17-23 and 57-60, drawn to a wand for a surgical anastomosis apparatus, classified in class 606, subclass 108.
- III. Claims 24-41, drawn to an anastomosis appliance and applicator and wand, classified in class 606, subclass

151.

IV. Claims 42-56, drawn to an anastomosis appliance and applicator, classified in class 606, subclass 191.

According to the official action:

"2. Invention I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not claim the wand as containing wand positioning means. The subcombination has separate utility such as an anastomosing wand used without connection to the mobile console."

"4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not claim a wand positioning means. The subcombination has separate utility such as an anastomosing device without attachment to the mobile console."

"6. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility

by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination claims the use of a stylus with an anastomosis appliance and applicator while the subcombination does not. The subcombination has separate utility such as an appliance and applicator not connected to the cart."

"8. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not claim use of linear and rotary mechanical actuators while the subcombination does. The subcombination has separate utility such as anastomosing wand that is controlled manually."

"10. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II (wand) has separate utility such as manually controlled anastomosing wand. See MPEP §806.05(d)."

"12. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination (appliance and

applicator) requires a housing having a transmission and an appliance applicator portion while the combination does not claim these elements. The subcombination has separate utility such as a blood vessel gripper."

The examiner contends that the inventions are independent and distinct for the reasons given in the office action and that there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification.

ELECTION

Applicant hereby elects the invention of Group III, claims 24-41, with traverse.

The present application is directed to an apparatus and method for performing anastomoses of blood vessels in the human body, which employs computer aided, automated features to ensure proper alignment and joining of the vessels.

In its broadest form as recited in claim 1, the apparatus comprises a mobile console housing a power supply, computer control means and manipulator means, a plurality of self contained anastomosis appliance and applicator assemblies attachable to the manipulator means and actuated by the computer control means, whereby the anastomosis appliance and applicator assemblies are capable of drawing together and securing two prepared blood vessels to form an anastomosis. The subsequent independent and dependent claims recite, with greater

specificity, the particulars of the broadly recited structure and means of claim 1.

TRAVERSE

First Restriction

With regard to inventions I and II, the examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not claim the wand as containing wand positioning means."

Applicants respectfully point out that none of the claims currently pending in the present application recite the wand "as containing wand positioning means." In point of fact, the wand does not contain a wand positioning means as the examiner appears to suggest. Rather, the wand is attached to the wand positioning means which itself comprises the position arm and the working arm as recited in claim 2.

As claim 17 recites, the wand positioning means "is adapted to provide gross and fine positioning of said wand and anastomosis appliance and applicator relative to blood vessels to be anastomosed ...". When this recitation is considered in light of the recitation of the positioning arm, the working arm and wand in claim 2, i.e. "a positioning arm extendable horizontally from said mast assembly and rotatable horizontally relative thereto, a working arm connected to said positioning arm at one end remote from said mast assembly and rotatable and pivotable

relative to said positioning arm, and a manipulatable wand connected to said working arm remote from said positioning arm, said wand being rotatable and pivotable relative to said working arm and having an end adapted to removably receive said anastomosis appliance and applicator assemblies", it is clear that the "wand positioning means" of claim 17 corresponds to the "positioning arm" and "working arm" of claim 2. Furthermore, when these claims are considered with the written description of the apparatus at pages 26-31 and pages 38-40, it becomes clear the operation of the apparatus as a whole is such that the positioning arm provides the gross positioning of the wand while the working arm provides the fine positioning of the wand.

With regard to the allegation of separate use, Applicants note that the language for showing distinction is that "(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." Note that use of the conjunction "and", rather than "or", indicates that both conditions must be met for the identified combination and subcombination to be distinct. Accordingly, a showing that one of the conditions has not been met is sufficient to overcome the contention of distinction. Thus, since it has been shown that combination requires the identified particulars of the subcombination, whether or not the subcombination has utility by itself or in other combinations is

not relevant.

In view of the foregoing, Applicants respectfully submit that the claims of group II, the subcombination, do not recite the wand "as containing wand positioning means" and that the claims of group I, the combination, recite the wand positioning means in the form of its specific elements, i.e., the positioning arm and the working arm. Thus, the inventions of groups I and II are not distinct and restriction is not proper. Applicants respectfully submit that the examiner's restriction between the claims of groups I and II has been traversed and should be withdrawn.

Second Restriction

With regard to inventions I and III, the examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not claim a wand positioning means."

For the reasons given above in connection with the restriction between groups I and II, Applicants respectfully point out that the "wand positioning means" of claim 24 corresponds to "the positioning arm" and "the working arm" recited in claim 2. The positioning arm and the working arm are elements found in all disclosed embodiments of the present invention, see Figs 10C and 43, and serve to provide the gross positioning of the wand, through the positioning arm, and fine positioning of the wand, through the working arm. When the

claims of groups I and III are considered with the written description of the apparatus at pages 26-31 and pages 38-40, it becomes clear that the operation of the apparatus as a whole is such that the positioning arm provides the gross positioning of the wand while the working arm provides the fine positioning of the wand. Thus, the positioning arm and the working arm are the wand positioning means.

With regard to the allegation of separate use, Applicants note that the language for showing distinction is that "(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." Note that use of the conjunction "and", rather than "or", indicates that both conditions must be met for the identified combination and subcombination to be distinct. Accordingly, a showing that one of the conditions has not been met is sufficient to overcome the contention of distinction. Thus, since it has been shown that combination requires the identified particulars of the subcombination, whether or not the subcombination has utility by itself or in other combinations is not relevant.

In view of the foregoing, Applicants respectfully submit that the claims of group I, the combination, recite the wand positioning means in the form of its specific elements, i.e., the positioning arm and the working arm. Thus, the

inventions of groups I and III are not distinct and restriction is not proper. Applicants respectfully submit that the examiner's restriction between the claims of groups I and III has been traversed and should be withdrawn.

Third Restriction

With regard to inventions I and IV, the examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination claims the use of a stylus with the anastomosis appliance and applicator while the subcombination does not."

Applicants respectfully traverse this ground of restriction for the reason that the examiner is attempting to compare and equate separate elements of the apparatus of the present invention. As is clearly recited in claim 12, the stylus is part of the manipulatable wand and is "connected to the proximal end of said handle and having an interface adapted to receive and transfer mechanical motion from said mechanical transfer means to said anastomosis appliance and applicator assemblies". Claims 42-56 of Group IV recite the structure of the anastomosis appliance and applicator of claim 12. Indeed, claim 42 recites the anastomosis appliance and applicator as "comprising a housing having a transmission portion and an appliance applicator portion, said transmission portion containing a drive mechanism adapted to operate said appliance applicator and adapted to receive and connect to a remote power

source...". When this recitation is considered in light of the written description at pages 54-55 and drawing figures 27A-C, it is clear that the "remote power source" which the transmission portion of the housing is adapted to receive and connect to is the end of the stylus which is a part of the manipulatable wand and includes means to transmit power from the wand to the appliance applicator. Since the disclosure describes the power to operate the appliance applicator as being transmitted by the wand through the stylus by which the appliance applicator is connected to the wand, it is clear that the appliance applicator of group IV, claims 42-56, operates by means of the stylus of the wand being connected to the appliance applicator.

Furthermore, Applicants respectfully submit that the examiner's contention that the "the combination as claimed does not require the particulars of the subcombination as claimed" does not follow the reason given, i.e., "because the combination claims the use of a stylus with the anastomosis appliance and applicator while the subcombination does not."

To follow that "the combination as claimed does not require the particulars of the subcombination as claimed", there must be something in the subcombination that is not claimed in the combination, not vice versa. In this regard, Applicants respectfully point out that group I, claims 1-16, are directed to the broad apparatus which comprises a mobile console housing a power supply, computer control means and manipulator means, a

plurality of self contained anastomosis appliance and applicator assemblies attachable to the manipulator means and actuated by the computer control means, whereby the anastomosis appliance and applicator assemblies are capable of drawing together and securing two prepared blood vessels to form an anastomosis. Group IV, claims 42-56 are directed to the anastomosis appliance and applicator assemblies recited in group I as part of the overall apparatus. Accordingly, Applicants respectfully submit that the combination, by recitation of the anastomosis appliance and applicator assemblies, does require the particulars of the subcombination which is directed to the specific structure of the anastomosis appliance and applicator.

With regard to the allegation of separate use, Applicants note that the language for showing distinction is that "(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." Note that use of the conjunction "and", rather than "or", indicates that both conditions must be met for the identified combination and subcombination to be distinct. Accordingly, a showing that one of the conditions has not been met is sufficient to overcome the contention of distinction. Thus, since it has been shown that combination requires the identified particulars of the subcombination, whether or not the subcombination has utility by itself or in other combinations is

not relevant.

In view of the foregoing, Applicants respectfully submit that the claims of group I, the combination, broadly recite and therefore require the particulars of group IV, the subcombination. Thus, the inventions of groups I and IV are not distinct and restriction is not proper. Applicants respectfully submit that the examiner's restriction between the claims of groups I and IV has been traversed and should be withdrawn.

Fourth Restriction

With regard to inventions III and II, the examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not claim use of linear and rotary mechanical actuators while the subcombination does."

Applicants respectfully traverse this ground of rejection and direct the examiner's attention to the fact that the claim 24, the independent claim of group III recites a "mechanical actuator means" as does claim 17, the independent claim of group II. Indeed, claim 17 corresponds to the preamble of claim 24. The recitation to a specific form of mechanical actuator, i.e., "a linear actuator and a rotary actuator" does not occur until claim 18, which is dependent from claim 17.

With regard to the allegation of separate use, Applicants note that the language for showing distinction is that "(1) the combination as claimed does not require the particulars

of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." Note that use of the conjunction "and", rather than "or", indicates that both conditions must be met for the identified combination and subcombination to be distinct. Accordingly, a showing that one of the conditions has not been met is sufficient to overcome the contention of distinction. Thus, since it has been shown that combination requires the identified particulars of the subcombination, whether or not the subcombination has utility by itself or in other combinations is not relevant.

In view of the corresponding language of the independent claims of groups II and III, Applicants respectfully submit that the inventions of group II and group III are not distinct and restriction is not proper. Applicants respectfully submit that the examiner's restriction between the claims of groups III and II has been traversed and should be withdrawn.

Fifth Restriction

With regard to inventions II and IV, the examiner contends that "the inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination II (wand) has separate utility such as manually

controlled anastomosing wand."

Applicants respectfully traverse this ground of restriction and can only presume that the examiner is referring to the recitation in claim 23 of group II to the "manual control means to activate and deactivate the electronic control means" of the wand. Note that Applicants have previously pointed out that the appliance applicator of group IV is used with the wand in that the transmission portion of the appliance applicator housing receives and connects to the remote power source via the stylus of the wand (see Applicants' comments in connection with the Third Restriction).

Considering the language of the rest of claims of group II, it is clear that the electronic control means control the actual operation of the wand and the anastomosis appliance and applicator connected thereto and that the "manual control means" merely activates and deactivates the electronic control means in the manner of a switch. Accordingly, the examiner's supposed separate utility is not, in fact, separate.

Furthermore, Applicants note that group II requires the anastomosis appliance and applicator of group IV by the language of claim 17 which recites:

An anastomosis apparatus comprising a manipulatable wand adapted to operate a self contained anastomosis appliance and applicator attached thereto, a wand positioning means adapted to provide gross and fine positioning of said wand and anastomosis appliance and applicator relative to blood vessels to be anastomosed, and computer control means adapted to sequentially

actuate said anastomosis appliance and applicator in response to data input relative to the type of anastomosis to be performed, wherein said wand comprises a functional unit housing a power supply, an electronic control means and a mechanical actuator means, a transmission means, and an anastomosis appliance and applicator interface.

Note that the purpose of the wand is to operate the self contained anastomosis appliance and applicator which is attached to the wand and actuated thereby through an anastomosis appliance and applicator interface. Accordingly, Applicants respectfully submit that the inventions of groups II and IV are inextricably linked.

With regard to the allegation of separate use, Applicants note that the language for showing distinction is that "(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." Note that use of the conjunction "and", rather than "or", indicates that both conditions must be met for the identified combination and subcombination to be distinct. Accordingly, a showing that one of the conditions has not been met is sufficient to overcome the contention of distinction. Thus, since it has been shown that combination requires the identified particulars of the subcombination, whether or not the subcombination has utility by itself or in other combinations is not relevant.

In view of the foregoing, Applicants respectfully submit that the inventions of group II and group IV are not

distinct and restriction is not proper. Applicants respectfully submit that the examiner's restriction between the claims of groups II and IV has been traversed and should be withdrawn.

Sixth Restriction

With regard to inventions III and IV, the examiner contends that "the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination (appliance and applicator) requires a housing having a transmission and an appliance applicator portion while the combination does not claim these elements."

Applicants respectfully traverse this ground of restriction and can only presume that the examiner has overlooked the language in claim 24 of group III at lines 1-12 which recites "wherein said anastomosis appliance and applicator comprises a housing having a transmission portion and an appliance/applicator portion". This is the same language that is found at lines 1-2 of claim 42 in group IV. Thus, the specific elements referred to by the examiner in the present restriction are found in both the combination and the subcombination as recited in the claims.

With regard to the allegation of separate use, Applicants note that the language for showing distinction is that "(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." Note that use of the conjunction "and", rather

than "or", indicates that both conditions must be met for the identified combination and subcombination to be distinct. Accordingly, a showing that one of the conditions has not been met is sufficient to overcome the contention of distinction. Thus, since it has been shown that combination requires the identified particulars of the subcombination, whether or not the subcombination has utility by itself or in other combinations is not relevant.

In view of the foregoing, Applicants respectfully submit that the inventions of group III and group IV are not distinct and restriction is not proper. Applicants respectfully submit that the examiner's restriction between the claims of groups III and IV has been traversed and should be withdrawn.

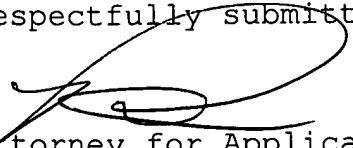
Conclusion

In view of the foregoing, Applicants respectfully submit that the examiner's grounds for restriction between the alleged separate inventions of groups I-IV as set forth in the office action have been traversed. The inventions recited in the present claims are related but are not of sufficient distinction so as to be separately patentable as claimed. Applicants therefore respectfully submit that the claims of the present application should be examined together in their entireties. Accordingly, Applicants respectfully submit that prosecution on the merits should proceed with respect to all disclosed embodiments and all claims, and that all claims are in allowable

form.

An early notice of allowance is earnestly solicited.

Respectfully submitted,



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